

## REMARKS

All the claims submitted for examination have been objected to and/or rejected.

Applicant has amended his claims and respectfully submits that all the claims currently in this application are patentable over the objections and rejections of record.

Turning first to the objections of record, the first of these objections is directed to Claim 4. Claim 4 stands objected to, under 37 C.F.R. §1.75(c), as being improperly dependent for failure to further limit the subject matter of a previous claim. Specifically, the species, “amine carboxylic acids,” a member of the Markush group recited in Claim 4, does not further limit alkanecarboxylic acids or arylcarboxylic acids, the two members of the Markush group of Claim 3, from which Claim 4 depends.

To overcome this objection, the species “amine carboxylic acids” in Claim 4 has been deleted. That species, however, has added to the Markush group of Claim 3.

Claim 5 stands objected to, under 37 C.F.R. §1.75(c), as being improperly dependent for failing to further limit the subject matter of a previous claim. Specifically, formic acid, oxalic acid and ethylenediamine tetraacetic acid, members of the Markush group recited in Claim 5, fail to restrict any of the Markush group members of Claim 4, from which Claim 5 depends.

Applicant has deleted these three species of the Markush group of Claim 5. However, a fourth Markush group member recited in Claim 5, which allegedly fails to further restrict a member of any of the Markush group members of Claim 4, benzene tricarboxylic acid, has not been deleted. This is because Claim 4 has been further amended to add the group -- aryltricarboxylic acids-- to the Markush group of that claim. Obviously, benzene tricarboxylic acid is a species of aryltricarboxylic acids.

That the addition of the species --aryltricarboxylic acids-- represents no new matter when added to the Markush group of Claim 4 is established by the recitation, in the originally filed specification at Page 9, line 14, wherein it is stated that aryltricarboxylic acid is an exemplary carboxylic acid within the scope of carboxylic acids within the contemplation of organic acids.

The third objection is directed to Claim 15. Claim 15 stands objected to, under 37 C.F.R. §1.75(c), as being improperly dependent for failing to further limit the subject matter of a previous claim. Specifically, Claim 15 includes the recitation, in the Markush group recited therein, of “amine carboxylic acids.” That species fails to limit any of the Markush group members recited in Claim 14, from which Claim 15 depends.

To overcome this ground of rejection the species “amine carboxylic acids” has been cancelled from that claim. It is noted that the species “amine carboxylic acids” has been added to the Markush group of Claim 14.

The fourth objection of record is directed to Claim 16. Claim 16 stands objected to, under 37 C.F.R. §1.75(c), as being improperly dependent for failing to further limit the subject matter of a previous claim. Specifically, three of the Markush group members of that claim, formic acid, oxalic acid and ethylenediamine tetraacetic acid, do not depend from any of the Markush group members recited in Claim 15, from which Claim 16 depends.

The aforementioned species of the originally recited Markush group of Claim 16 have been deleted. It is noted that these species have been added to the Markush group of Claim 14.

A fourth species, benzene tricarboxylic acid, which was also objected to as having no antecedent basis in any of the members of the Markush group recited in Claim 15 has been

retained in Claim 16. To provide support for this Markush group member of Claim 16, the species --aryltricarboxylic acids-- has been added to Claim 15. The addition of this species to the Markush group of Claim 15 provides support for the Markush group member benzene tricarboxylic acid in Claim 16.

It is emphasized that the addition of --aryltricarboxylic acids--, introduced into Claim 15, is fully supported by the aforementioned recitation in the specification at Page 9, line 14.

The fifth objection of record is directed to Claim 20. Claim 20 stands objected to, under 37 C.F.R. §1.75(c), as being improperly dependent for failing to further limit the subject matter of a previous claim. Specifically the species “amine carboxylic acids,” recited in Claim 20, limits none of the four Markush group member original set forth in Claim 19, from which Claim 20 depends.

Claim 20 has been amended to delete the objected to species, “amine carboxylic acids.” That species, however, has been added to the Markush group of Claim 19.

One formal ground of rejection is imposed in the outstanding Official Action. That rejection, directed to Claims 8 and 9, is a rejection imposed under 35 U.S.C. §112, second paragraph. Specifically, Claims 8 and 9 stand rejected, under 35 U.S.C. §112, second paragraph, as being indefinite for inclusion of the recitation “said photoimageable composition.” The Official Action correctly avers that “photoimageable composition” finds insufficient antecedent basis in Claim 1, from which Claim 8 depends, to support this recitation.

Applicants have cancelled the limitation prompting this formal rejection of record. In its place applicants have inserted the term --said photoresist composition--. Insofar as Claim 1 is directed to a photoresist composition, the introduction of this term provides antecedent

basis for the recitation --said photoresist composition--, at line 2 of Claim 8. Obviously, the deleted term was a typographical error. Indeed, the Official Action indicates that, for the purpose of examination of Claim 8 on the merits, an assumption is made that applicant meant to recite --said photoresist composition.--

One substantive ground of rejection has been imposed in the outstanding Official Action. That rejection, directed to all the claims currently in this application, Claims 1-20, is imposed under 35 U.S.C. §102(b). Specifically, Claims 1 to 20 stand rejected as being anticipated by U.S. Patent 6,004,725 to Barr et al.

The Official Action avers that Barr et al. teaches a negative acting photoimageable composition useful for manufacturing printed circuits comprising a binder having an acid number of 239 and another binder having an acid number of 149, 9-phenyl acridine and 0.06 wt % of o-phthalic acid. As such, the Official Action concludes that Barr et al. reads on a photoactive component and an organic acid within the contemplation of independent Claims 1, 12 and 18 of the present application.

It is unnecessary to address the argument, summarized at Page 5 of the outstanding Official Action, in support of the proposition that Barr et al. anticipates Claims 1 to 20 of the present application. Suffice it to say, applicants have made this rejection moot by amending Claims 1, 12 and 18, the three independent claims currently in this application, from which all the remaining claims ultimately depend, and submit that, as amended, the claims of the present application are novel over Barr et al.

The amendment to the independent claims of the present application limit all the claims currently in this application to a photoresist composition which includes an organic acid present in an amount of 0.125 wt % or greater, based on the total dry weight of the

polymeric binder. This limitation is explicitly outside the range disclosed by Barr et al.

Attention is directed to the only recitation of concentrations recited in Barr et al.

Specifically, applicant points to the example in Barr et al. That example is summarized in the table at Column 5. Therein, o-phthalic acid, the sole organic acid within the contemplation of that term, as defined by the claims of the present application, is present in a concentration of 0.06 wt %, a concentration of only half the recited minimum concentration of 0.125 wt % required in the amended claims of the present application.

It is emphasized that the new limitation, which clearly establishes the novelty of the claims of the present application, e.g. that the organic acid is present in an amount of 0.125 wt % or greater, based on the total dry weight of the polymeric binder, is fully supported by the recitation at Page 10, lines 1-4 of the originally filed specification.

In further regard to the concentration ranges of the organic acid it is noted that Claims 10 and 11 have been amended to indicate that the recited concentrations are also based on the total dry weight of the polymeric binder. Of course, this recitation is provided in a surfeit of caution, insofar as Claim 10 depends from Claim 1 and Claim 11 depends from Claim 10.

It should be appreciated that many of the claims have been amended to correct obvious defects in Markush group claiming language. In addition, Claims 6, 12 and 20 have been amended to correct typographical errors in the spelling of “anthraquinone,” to introduce the indefinite article “a” proceeding “polymeric binder” and delete the double recitation of “from,” respectively.

The above amendment and remarks establish the patentable nature of all the claims currently in this application. Notice of Allowance and passage to issue of these claims,

Claims 1-20, is therefore respectfully solicited.

Respectfully submitted,



Marvin Bressler  
Registration No. 25,132  
Attorney for Applicant

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
516-742-4343  
MB:ml